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**(2011) 12 MAD CK 0321**

**In the Madras High Court**

**Case No :** Writ Petition No. 28033 of 2011

| | |
|---|---|
| Schering-Plough Ltd., (A Swiss Company) | APPELLANT |
| Vs | |
| Intellectual Property Appellate Board, Guna Complex, Annexe - I, 2nd Floor, 443, Anna Salai, Teynampet, Chennai - 600018 and Assistant Controller of Patents and Designs, Government of India, Patent Office, Intellectual Property Rights Building, G.S.T. Road, Guindy, Chennai - 600032 | RESPONDENT |

**Date of Decision :** 08-12-2011

**Acts Referred:**
Limitation Act, 1963 — Section 5
Patents Act, 1970 — Section 11(B), 13(3), 14, 15

**Citation :** (2011) 12 MAD CK 0321

**Hon'ble Judges :** M.Y. Eqbal, C.J;T.S. Sivagnanam, J

**Bench :** Division Bench

**Advocate :** Ananthpadmanabhan, for the Appellant; S. Kesavan, S.P.C.C.G., for the Respondent

**Final Decision :** Allowed

## Judgement

Hon''ble Chief Justice Mr. M.Y. Eqbal & T.S.Sivagnanam, J.—This writ petition has been filed seeking a writ of certiorarified mandamus to call for the records of the 1st respondent and quash the order dated 13.06.2011 in C.O.D.No. 4/2009 in S.R.No. 405/2009/PT/IPAB and consequently direct the 1st respondent to consider on merits the appeal filed against the order of the 2nd respondent dated 05.01.2009 in Patent Application No. 2376/CHENP/2006.

2. It is stated that the petitioner is a Swiss Pharmaceutical Company having huge investments in Research and Development (R&D) for developing new and innovative drugs for the benefit of the consumer public. As part of its R&D programme, the petitioner-company embarked on research to provide Growth Differentiation Factor 8 (GDF8) peptides comprising a specific neutralizing epitope for GDF8. After coming out with the process for isolating these GDF8 peptides, the petitioner applied for an international patent in respect of these

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peptides vide Application No. PCT/US04/43125 dated 21.12.2004. In India, the petitioner-company filed an application for patent on 29th June, 2006 and it was numbered as 2376/CHENP/2006. On the very same day, the petitioner-company made a request for examination under Form-18 in accordance with Section 11B of the Patents Act, 1970 (for short "Act"). After the examination of the petitioner''s application for patent the First Examination Report (FER) was issued on 08.10.2007 asking the petitioner to clarify the objections raised therein. In response to the same, the petitioner-company submitted its response to the FER on 08.08.08 claiming objections 1 to 11 raised in the FER as incorrect and it also carried out some minor amendments to the patent application. Thereafter, the 2nd respondent examined the amended specification u/s 13(3) of the Act and issued his examination report on 07.10.2008. The petitioner alleges that in the said report also the 2nd respondent merely repeated that Claims 1 to 14 cannot be allowed as they lack both novelty and inventive step, and the nucleic acid and the peptide claimed by the applicant are not novel. There was no reason stated in the report in favor of the view taken by the 2nd respondent. On 10.10.2008 reply u/s 14 of the Act was also submitted. Finally, on 05.01.2009 the 2nd respondent passed the final order u/s 15 of the Act refusing patent on the ground that none of the claim was novel or inventive. In the said order the 2nd respondent went beyond the objections already raised in the FER (First Examination Report) and wholly new grounds and reasons were given in the order.

3. Aggrieved against the order of the 2nd respondent, the petitioner filed an appeal before the 1st respondent on 05.10.2009 with a delay of 183 days. Therefore, the petitioner filed a separate application along with the appeal giving details as to why such delay occurred and praying condo nation of the delay. The 1st respondent vide its order dated 13th June, 2011 dismissed the application on the ground that no sufficient cause is shown for the condo nation of delay. Aggrieved against the same, the petitioner has preferred the present writ petition.

4. We have heard the learned counsel for the parties and perused the impugned order passed by the Intellectual Property Appellate Board (in short "Appellate Board"). The Appellate Board dismissed the condo nation petition by stating that the affidavit filed in support of the delay petition contains no reasons. The relevant portion of the order is extracted herein below:-

In the present case, the affidavit filed in support for condo nation of delay contains no reasons. Apart from this, the affidavit says that they have a good case on merits and the delay was beyond their control. The Patents Act, 1970 gives the aggrieved party three months to file the appeal. The communication systems of today are so swift that we do not think any period of three months is too short. These are days of electronic communication, conference calls and even video conferencing. In spite of that if three months time is not enough, the appellant should give sufficient reasons for that. Going through the paras 6 and 7 merely states that they require time to brief the advocate which is not adequate

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reason.....

5. Prima facie we are of the view that the Appellate Board has not correctly appreciated the reasons for delay disclosed in the affidavit accompanying the delay petition. It was categorically stated in the affidavit filed in support of the delay petition that upon receipt of the order of the 2nd respondent the petitioner-company had to receive technical support from its experts. Further, the petitioner-company is a foreign company situated in Switzerland and requires time to brief their advocate in India on the technical information. It was further stated that the petitioner-company had done everything in their control to file the appeal against the order of the 2nd respondent, but because of the intervening circumstances the delay occurred, which was beyond their control. It was also stated that the petitioner-company has a good case on merit and the interest of justice and fairness requires that the delay in filing the appeal be condoned and the appeal be heard on merits.

6. Although the Appellate Board noticed the ratio decided by the Supreme Court in N. Balakrishnan Vs. M. Krishnamurthy, yet it has not correctly appreciated the law in favor of the appellant/writ petitioner while considering the application for condo nation of delay.

7. It is well settled by the Supreme Court that there cannot be any hard and fast rule to be laid down as to what constitutes sufficient cause. The expression "sufficient cause" should receive liberal construction. In the case of O.P. Kathpalia Vs. Lakhmir Singh (Dead) and Others, a three-Judge Bench of the Supreme Court held that if the refusal to condone the delay result in grave mis-carriage of justice, it would be a ground to condone the delay.

8. In another decision in the case of Collector, Land Acquisition v. Mst. Katiji, AIR 1987 SC 306 their Lordships observed:-

The legislature has conferred the power to condone delay by enacting Section 5 of the Limitation Act of 1963 in order to enable the Courts to do substantial justice to parties by disposing of matters on ''merits''. The expression ''sufficient cause'' employed by the legislature is adequately elastic to enable the Courts to apply the law in a meaningful manner which sub serves the ends of justice that being the life-purpose of the existence of the institution of Courts. It is common knowledge that this Court has been making a justifiably liberal approach in matters instituted in this Court. But the message does not appear to have percolated down to all the other Courts in the hierarchy.

9. Similar view has been taken by the Supreme Court in a catena of decisions holding that the expression "sufficient cause" should be liberally construed. In the instant case, the Appellate Board has not correctly appreciated the law laid down by the Supreme Court. Hence, the impugned order needs interference.

10. For the aforesaid reasons, this writ petition is allowed and the impugned order passed by the 1st respondent - Appellate Board is set aside, and the

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matter is remitted back to the 1st respondent - Appellate Board to hear the matter afresh in accordance with law. No costs.

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